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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,004	01/29/2002	Sergio Belli	5788.0077.02	4774

22852 7590 01/15/2003

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EXAMINER

MAYO III, WILLIAM H

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,004

Applicant(s)

BELLI ET AL.

Examiner

William H. Mayo III

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-100 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 70-73 is/are allowed.
- 6) ☒ Claim(s) 55-69 and 74-100 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 29 January 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/261,505.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☒ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in present Application No. 09/261,505, filed on March 3, 1999.

Information Disclosure Statement

2. The information disclosure statement filed January 29, 2001 has been submitted for consideration by the Office. It has been placed in the application file and the information referred to therein has been considered.

Drawings

3. The corrected or substitute drawings were received on January 29, 2002. These drawings are approved.

Specification

4. The abstract of the disclosure is objected to because the term "comprising" appears in line 3 which is improper language for the abstract. The applicant should replace the terms like --having--. Correction is required. See MPEP § 608.01(b).
5. In the abstract please delete the reference to Fig 1 at the bottom of the page.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 55-69 and 74-100 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for some material of the copied claims, the specification of the applicant does not reasonably provide enablement for specified copied claim limitations as detailed below. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The copied claim limitations "...a material being flowable at about 25°C" is not enabled by the applicant's specification and therefore is not enable by applicant's specification. Specifically, the applicant's specification specifies that "the sealing material is flowable at ambient temperature " doesn't enable the specific claim limitation of the materials being flowable at about 25°C. In light of the above statement, claims 55, 59, 74, 84, 97, 99, and 100 are rejected for containing claim language that is not enabled by the specification. The copied claim limitations "...wherein the material has a 100 gram needle penetration value of greater than 100 tenths of a millimeter at 25°C" is not supported by the applicant's specification and therefore is not enable by applicant's specification. Specifically, the applicant's specification specifies that "the sealing material may be Vistanex ®" and the applicant attaches Exhibit E to support that the material has a 100

gram needle penetration value of greater than 100 tenths of a millimeter at 25°C, the applicant doesn't specify in the specification that the Vistanex material is can actually be Vistanex LM or Vistanex LM-LC. The general recitation of a material cannot encompass a wide variety of specific forms of the material. In light of the previous statement, claims 56, 61, 75, and 86 are rejected for containing claim language that is not enabled by the specification. The applicant's claims specifying that "the material is substantially free of solvents and oils" is not enabled by the applicant's specification. Specifically, the applicant's specification specifies that "the sealing material contains oils (see page 10, lines 20-35, i.e. polyisobutene with minor amounts of α -olefins). In light of the previous statement, claim 77 is rejected. The applicant's claims specifying that "the sealing material is made from low molecular weight copolymers of an isomer", is not enabled by the specification. Specifically, the applicant's specification specifies that "the sealing material is an average molecular weigh material (see page 10, lines 36-39). In light of the previous statement, claim 79 is rejected. Claims 57-58, 60, 62-69, 76, 78, 80-83, 85, 87-96, and 98 are depended upon rejected claims and therefore are rejected.

Allowable Subject Matter

8. Claims 70-73 are allowed.
9. The following is an examiner's statement of reasons for allowance: Based on the fact that the above claims are copied claims of US Patent Numbers 6,184,473 and 6,359,231, they are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. Based on the fact that the remaining claims are also copied claims of US Patent Numbers 6,184,473 and 6,359,231, the claims would be allowable if the 35 USC 112 rejection is overcome.

Communication


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (703) 306-9061. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308-3682. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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January 13, 2003